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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,611	03/17/2004	Guennadiy Eremin	4194-032081	4347

28289 7590 12/03/2004

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EXAMINER

HAAS, WENDY C

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
10/802,611	EREMIN, GUENNADY	
Examiner	Art Unit	
Wendy C Haas	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 17 March 2004.  
2a) This action is FINAL.      2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on 17 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Specification***

The abstract of the disclosure is objected to because it does not describe the invention set forth in the specification. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, applicant claims “[a] new and distinct variety of *Prunus lannesiana* x *Prunus persica* plant ...” but discloses in the specification a *Prunus cerasifera* x *Prunus persica* plant.

***Objection to the Disclosure***

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) *The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.*

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

*The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.*

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

*No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.*

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

**More specifically:**

- A. Page 1, the words "cytospora" and "verticillium" must be changed to read —*Cytospora*— and —*Verticillium*--.

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B. Applicant should provide the typical and observed conditions the plant as described was grown under in the location of culture. In addition, applicants should specify what age the claimed plant was at the time it was described in the Description of the Plant.

C. The Specification is not in the proper format and does not include the correct title headings for the various sections of the specification. Applicant is directed to consult Chapter 1600 of the MPEP for the proper format.

D. Page 2, applicant should specify whether the description of fruit bearing relates to the claimed plant grown as a tree or to the rootstock's effect on scion cultivars.

E. Applicant must provide the following detailed botanical information regarding the claimed plant:

1. The height and spread of the tree at a given age in a specific location of culture
2. The diameter of the trunk at a specific height from the ground at a given age.
3. The trunk texture
4. Number and concentration of lenticels on trunk and branches
5. Branch diameter, crotch angle, lenticel concentration
6. Lenticel size and shape
7. Leaf bud length, diameter and color
8. Leaf shape, base shape, apex shape and margin shape
9. Petiole diameter

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10. Stipule number and width

11. Flower diameter, depth, petal shape, apex shape, base shape and margin shape and whether the flower is showy or not showy

12. Pistil number, stamen number, pollen amount

13. Fruit weight

14. Stem cavity depth and breadth in quantitative terms

15. Penetrometer reading for fruit flesh firmness

16. Descriptions of the color of the following plant parts with reference to a known color chart:

- a. Trunk
- b. Branch bark (new and mature growth)
- c. Upper and lower leaf surfaces
- d. Leaf veins and petioles
- e. Lenticels
- f. Stipules
- g. Flower petal upper and lower surfaces
- h. Pistil
- i. Stamens
- j. Sepals
- k. Pollen
- l. Pedicels
- m. Fruit skin, flesh and pit

F. Applicant describes the claimed plant as chlorosis “[t]olerant to resistant”.

Clarification/additional information is needed, as it is unclear what information applicant is attempting to convey.

G. If available, applicant should set forth all particular fungal diseases and viruses the claimed plant is tolerant to.

H. Applicant describes the suckering of the claimed plant as very good – applicant should specify whether or not suckering is desirable, as it is impossible to tell what “very good” means without such information.

I. If available, applicant should set forth the cold hardiness of the claimed plant.

J. Applicant should specify what is meant by “medium to strong” vigor (i.e. does the rootstock impart vigor to the scion or is the plant grown as a whole vigorous?)

K. Applicant should specify whether or not there are any known graft incompatibilities with the claimed plant.

The above listing may not be complete. Applicant should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

**CLAIM REJECTION**

**35 U.S.C. § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

**CONCLUSION**

NO CLAIM IS ALLOWED.

**REFERENCES CITED**

The references cited show the state of the art.

**FUTURE CORRESPONDENCE**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

KENT BELL  
PRIMARY EXAMINER  
